UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,544	02/09/2002	Erland Wittkotter		9884

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EXAMINER
GURSHMAN, GRIGORY

ART UNIT	PAPER NUMBER
2132	

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>09 February 2002</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>09 February 2002</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☒ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date *5/27/2003*.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____ .

DETAILED ACTION

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter, which the applicant regards as his invention.

Claims 1-17 are rejected under the second paragraph of 35 U.S.C. § 112, because

the instant claims are generally narrative and indefinite, failing to conform with current

U.S. practice. They appear to be a literal translation into English from a foreign

document and are replete with grammatical and idiomatic errors.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the
> United States before the invention thereof by the applicant for patent, or on an international application
> by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this
> title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act

of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior

to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4.   Referring to the instant claims, Kondo discloses a method of and system for

processing electronic document and recording medium for recording processing

program (see abstract and Fig. 1). Kondo teaches that in an electronic document

circulating method of circulating an electronic document having a plurality of data blocks

to a plurality of workers, a data block in a document is encrypted by using an encrypting

key corresponding to a certain worker, and a document having the encrypted data block

is transmitted and received over a network. A time necessary for encrypting and

decrypting an electronic form may be reduced. The encrypted data block in the

document is decrypted by using a decrypting key corresponding to a specific worker,

and it is determined how to display the data block and execute a processing in response

to whether or not the encrypted data block is decrypted correctly or the existence of the

data block (see abstract).

5.   Referring to the independent claim 1, the limitation "decrypting of an encrypted

electronic document by means of a key data file that is introduced or delivered from a

server over a public data transmission network, preferably the internet" is met by Fig. 1

depicting the client-server communication system using the connection over the Internet

(22). The keys and encrypted electronic documents are sent over the internet through

the local area network 23 as shown in Figs. 2-3. The limitation "the decrypted electronic

document is displayable on a local data processing appliances" is met by teaching that

the encrypted data block in the document is decrypted by using a decrypting key

corresponding to a specific worker, and it is determined how to display the data block

(see abstract and Fig. 9). The limitation "a decryption unit that is used for combining or

joining the encrypted document with the key data file for generating the decrypted

document" is met by key data files depicted in Figs. 5A and 5B. Decryption unit is

shown in Fig.3, see block 192 using the key 451. The limitation "decryption unit ...which

is capable to be configured by selecting of a key data file from a plurality of local or

server sided available key data files" is met by teaching that the encrypted data block in

the document is decrypted by using a decrypting key corresponding to a specific worker

(see abstract), selected from a plurality of the keys 451 (in Fig. 3). The limitation "a

decryption operation of the decryption unit is influenced in a manner, that only with a

predetermined configuration of the function unit the combining or integrating in the

decryption unit lead to the correct decrypted document" is inherently taught in Kondo,

because he teaches that only when the decryption unit selects the appropriate key file

for the particular worker receiving the encrypted document, the document is decrypted

correctly and displayed. The limitation "the predetermined configuration of the function

unit is installed or established... comprise a parameter setting of the function unit or ...

an assignment of the program files..." is met by form processing defining and execution

program (194 in Fig. 4).

6.   Referring to claim 2, Kondo shows the decryption program being a part of the

browser (see Fig. 9).

7.   Referring to claim 3, Kondo teaches the use of a form data encrypting program,

which meets the limitation "a programming or script language and ... means of digital

signature".

8.   Referring to claim 4, Kondo teaches encrypting an electronic document.

Therefore, Kondo inherently teaches that key data file contains the information

"arranged in manner that reconstruction of the original amount of data is permitted".

9.   Referring to claim 5, Kondo teaches encryption and decryption of an electronic

document (see Figs. 3-4). Therefore, Kondo inherently teaches "processing of the

encrypted amount of data and the key data file is arranged for generating of the

decrypted document".

10.   Referring to claims 7 and 8, Kondo teaches the use of a plurality of data files

(see keys 451 in Fig. 3).

11.   Referring to claims 11 and 12, Kondo teaches that decryption of the document

is based on the configuration which defines the program to be executed (see Fig. 8).

12.   Referring to claim 14, Kondo teaches that decryption of the document is

performed by an executable programs (see step 710 and 712 in Fig. 8).

13.   Referring to claim 15, Kondo teaches that encrypted documents are text files.

14.   Referring to claim 16, Kondo teaches the "proxy unit" in the form of the

electronic mail server (see Fig. 1).

15.   Referring to claim 17, all the steps recited in claim 17 for the decryption of the

electronic document are taught in Kondo. In particular Kondo teaches transmitting the

key data file, activating the decryption, decrypting the electronic document by electronic

processing of adapt stream corresponding to the key data file of the encrypted

document and displaying the decrypted document (see Figs. 9, 14 and 17).

Claim Rejections - 35 USC § 103

16.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

17.   Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo

(U.S. Patent No. 6.446.050 B1) in view of Yasukawa (U.S. Patent No. 5.999.622).

18.   Referring to claim 9, Kondo discloses a method of and system for processing

electronic document and recording medium for recording processing program (see

abstract and Fig. 1). Kondo teaches that in an electronic document circulating method

of circulating an electronic document having a plurality of data blocks to a plurality of

workers, a data block in a document is encrypted by using an encrypting key

corresponding to a certain worker, and a document having the encrypted data block is

transmitted and received over a network.

19.   Kondo , however, does not explicitly teach that encrypted electronic document

requires a renewed decryption after expiration of predetermined period of time.

Referring to claim 9, Yasukawa discloses a method and apparatus for protecting widely

distributed digital information (see abstract and Figs 2 and 3). Yasukawa teaches that if

the end user 34 has chosen to pay a fee for a limited duration (e.g. a few hours, days,

etc.), an internal timer is set corresponding to the time duration paid for. The end user

34 can then decrypt (i.e. use) the encrypted software until the internal timer expires.

After the timer expires, the decryption key 56 is marked as invalid by the Windows

operating system, and as a result, the end user 34 can no longer use the encrypted

software without paying an additional fee and obtaining a new decryption key 56 (see

column 6, lines 9-18).

20.   Therefore, at the time the invention was made, it would have been obvious to

one of ordinary skill in the art to modify the system of processing of the electronic

documents of Kondo, using the encryption, by having the expiration period of time for

the decryption key and requiring a renewed decryption key thereafter as taught in

Yasukawa. One of ordinary skill in the art would have been motivated to modify the

system of processing of the electronic documents of Kondo, using the encryption, by

having the expiration period of time for the decryption key and requiring a renewed

decryption key thereafter as taught in Yasukawa for having the capability to charge user

addition fees for the new decryption key (see Yasukawa, column 6, lines 17-18).

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Grigory Gurshman whose telephone number is

(571)272-3803. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Gilberto Barron can be reached on (571)272-3799. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Grigory Gurshman
Examiner
Art Unit 2132

GG

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